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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,186	12/01/2003	Thierry Roussel	03-45	9848

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EXAMINER

GUTMAN, HILARY L

ART UNIT	PAPER NUMBER
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3612

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/725,186

Applicant(s)

ROUSSEL ET AL.

Examiner

Hilary Gutman

Art Unit

3612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-38 is/are pending in the application.
- 4a) Of the above claim(s) 23,24,30,31,34-36 and 38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-22,25-29,32 and 37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/23/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Election/Restrictions

2. Claims 23-24, 30-31, 33-36, and 38 are hereby withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 2/16/05.
3. Applicant's election with traverse of species A in the reply filed on 2/16/05 is acknowledged. The traversal is on the ground(s) that the examiner failed to state reasons for the restriction and further that there is no serious burden placed upon the examiner. This is not found persuasive because on line 1 of the last action the examiner set forth that the application contains claims directed to two patentably distinct species. Additionally, the action set forth that should the applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. Furthermore, the examiner does indeed find the examination of the additional species and further the nine additional claims burdensome. The requirement is still deemed proper and is therefore made FINAL.

Drawings

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 80. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 27. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and

informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

6. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the bumper skin of claims 17 and 37, the side rails of claim 21 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

7. Claim 37 is objected to because of the following informalities: on line 4 the second period should be deleted. Appropriate correction is required.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 28 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 28 recites the broad recitation thermoplastic

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material, and the claim also recites polypropylene which is the narrower statement of the range/limitation.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 17, 20-22, 27, 29, 32, and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Carpenter et al.

Carpenter et al. (5,139,297) disclose a motor vehicle beam shell designed to be placed behind a bumper skin (or capable of being placed behind a bumper skin), the shell 16 having with a recess for receiving a strength member 10, the shell including shell cladding 8 which interfits with the shell, thereby forming a hollow body defining the recess for receiving the strength member.

With regard to claim 20, the strength member includes an outside shape and the recess is dimensioned to fit snugly around at least a region of the outside shape.

With regard to claim 21, the region is selected from the group consisting of a central portion of the shell and a portion of the shell that is disposed in register with side rails of the vehicle.

With regard to claim 22, the recess is defined by a portion of the shell that has an open cross-section.

With regard to claim 27, the shell may comprise a thermoplastic material.

With regard to claim 29, the shell cladding encloses the strength member.

With regard to claim 32, the recess consists of a channel.

For claim 37, Carpenter et al. disclose a motor vehicle beam designed to be placed behind a bumper skin (or capable of being placed behind a bumper skin), said beam including a strength member 10 and a shell 16 having with a recess for receiving a strength member, the shell including shell cladding 8 which interfits with the shell, thereby forming a hollow body defining the recess for receiving the strength member.

12. Claims 17-18, 20-22, 25, 29, 32, and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Klie et al.

Klie et al. (4,826,226) discloses a motor vehicle beam shell designed to be placed behind a bumper skin 1, the shell 3 having with a recess for receiving a strength member 15, the shell including shell cladding 6 which interfits with the shell, thereby forming a hollow body defining the recess for receiving the strength member.

With regard to claim 18, the strength member 15 comprises at least one material from the group consisting of metal and a composite material including a metal.

With regard to claim 20, the strength member includes an outside shape and the recess is dimensioned to fit snugly around at least a region of the outside shape.

With regard to claim 21, the region is selected from the group consisting of a central portion of the shell and a portion of the shell that is disposed in register with side rails of the vehicle.

With regard to claim 22, the recess is defined by a portion of the shell that has an open cross-section.

With regard to claim 25, the recess includes an impact-absorber 9.

With regard to claim 29, the shell cladding encloses the strength member.

With regard to claim 32, the recess consists of a channel.

For claim 37, Klie et al. disclose a motor vehicle beam designed to be placed behind a bumper skin 1, said beam including a strength member 15 and a shell 3 having with a recess for receiving a strength member, the shell including shell cladding 6 which interfits with the shell, thereby forming a hollow body defining the recess for receiving the strength member.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

15. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Klie et al. as applied to claim 18 above and in view of Roussel et al.

Klie et al. disclose the strength member being metal but lacks the metal comprising aluminum.

Roussel et al. (6,669,252) teach the use of aluminum for a strength member.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have allowed the metal to be aluminum as taught by Roussel et al. in order to provide a strong material that is lightweight.

16. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Klie et al. as applied to claim 25 above and in view of Tarahomi et al.

Klie et al. disclose the recess including an impact absorber 9 of foam but lack the impact absorber including honeycombs.

Tarahomi et al. (6,758,507) teach a honeycomb-like structure for an impact absorber within a bumper.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have allowed the impact absorber to include honeycomb as taught by Tarahomi et al. in order to allow for better and more controlled energy absorption during an impact.

17. Claims 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klie et al. as applied to claim 17 above and in view of Roussel et al.

Klie et al. disclose the shell of a metal material and lacks the shell comprising thermoplastic material and specifically polypropylene.

Roussel et al. (6,669,252) teach a thermoplastic polypropylene shell.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the shell from a polypropylene thermoplastic material as taught by Roussel et al. in order to allow the shell to be both rigidly strong and lightweight.

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hilary Gutman whose telephone number is 703-305-0496.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Dayoan can be reached on 703-308-3102. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

20. **Any response to this action should be mailed to:**

Assistant Commissioner for Patents

Washington, D.C. 20231


or faxed to:

(703) 872-9326, (for formal communications intended for entry)

or:

(703) 746-3515, (for informal or draft communications, please clearly label

"PROPOSED" or "DRAFT").


Hilary Gutman
March 11, 2005